

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Offic**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/007,268	01/14/98	LOWE,	J PC7981C

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 EXAMINER

DELACROIX MUIRHEI, C

ART UNIT	PAPER NUMBER
1614	<i>8</i>

DATE MAILED: 10/25/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/007,268

Applicant(s)

Lowe et al

Examiner

C. Delacoux-m

Group Art Unit

1654

 Responsive to communication(s) filed on 7/22/99 This action is FINAL. Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

 Claim(s) 1-32 is/are pending in the application. Of the above, claim(s) 2, 3-8, 10-18, 29, 31, 32 is/are withdrawn from consideration. Claim(s) _____ is/are allowed. Claim(s) 1, 9, 19-28, 30 is/are rejected. Claim(s) _____ is/are objected to. Claims _____ are subject to restriction or election requirement.

Application Papers

 See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948. The drawing(s) filed on _____ is/are objected to by the Examiner. The proposed drawing correction, filed on _____ is approved disapproved. The specification is objected to by the Examiner. The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

 Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d). All Some* None of the CERTIFIED copies of the priority documents have been received. received in Application No. (Series Code/Serial Number) _____. received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

 Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

 Notice of References Cited, PTO-892 Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ Interview Summary, PTO-413 Notice of Draftsperson's Patent Drawing Review, PTO-948 Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

DETAILED ACTION

The following is responsive to Applicant's election received Jul. 22, 1999.

No claims are cancelled, No new claims are added. Claims 1-32 are currently pending.

1. Applicant's election without traverse of Group II including a further election of species in the election received Jul. 22, 1999 is acknowledged.
2. Claims 1, 2-8, 10-18, 29, 31, 32 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected. Election was made **without** traverse in the election received Jul. 22, 1999.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Walker et al., CA55:27301i (abstract).

Walker et al. disclose the compounds 3-veratrylamino-piperidine hydrochloride, 3-[(p-dimethylaminobenzyl)amino]-piperidine trihydrochloride and 1-methyl-3-veratrylamino-piperidine dihydrochloride (structures shown in abstract), wherein said compounds read on Applicant's claim 1. See abstract.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Tchelitcheff, S., CA52:1279e (abstract).

Tchelitcheff discloses the compounds 3-benzylamino-1-ethyl-piperidine and 3[[p-(diethylaminomethyl)benzyl]amino]-1-ethyl-piperidine (structures shown in abstract). Said compounds read on Applicant's claim 1.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who

has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

6. Claims 1, 25-28, 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Rosen 5,686,615.

Rosen discloses a compound represented by Formula I, wherein R1 is phenyl and R2 is phenyl, wherein said compound is formulated into a pharmaceutical composition useful in treating depression. Please see col. 1-2; col. 6, lines 58-66.

7. Claims 1, 9, 19-28, 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Desai et al., 5,232,929.

Desai discloses nitrogen containing heterocyclic compounds represented by Formula I, wherein the substituents R1, R3, R7, R4, R2, R5, R6, R8, m and Y are substantially identical to substituents X1, X2, X3, and R6-R11, m and X, wherein Q is formula VII of Applicant's claims. Said compounds may be formulated into pharmaceutical compositions useful for the treatment of depression. Please see claims 1-58.

Double Patenting

8. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

9. Claim 9 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 3 (col. 13, lines 3-4) of prior U.S. Patent No. 5,576,317. This is a double patenting rejection.

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1, 9, 19-28, 30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 5,773,450. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and USPN '450 claim fluoroalkoxybenzylamino derivatives of nitrogen containing heterocycles represented by Formula I, wherein Q is formula VII. The scope of the claims in the instant application and those of USPN '450 overlap because the claims of the instant invention are broader and encompass the compounds of '450 due to the fact that the X substituent in the instant application is (CH₂)_q, wherein q is an integer from 1 to 6.
12. Claims 1, 9, 19-28, 30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-59 of U.S. Patent No. 5,232,929. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant invention and USPN '929 claim substantially identical aminopiperidine derivatives of nitrogen heterocycles, pharmaceutical compositions thereof and methods of treating various disorders, i.e. depression. The scope of the claims of the instant invention and those of '929 overlap because many of the defined substituents in Formula I, wherein Q is formula VII of the instant invention and the defined substituents of Formula I in '929 are identical.
13. Claims 1, 9, 19-28, 30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 5,688,804. Although the conflicting claims are not identical, they are not patentably distinct from each other

because both the instant invention and USPN '804 claim substantially identical aminopiperidine derivatives of nitrogen heterocycles, pharmaceutical compositions thereof and methods of treating various disorders, i.e. depression. The scope of the claims of the instant invention and those of '804 overlap because many of the defined substituents in Formula I, wherein Q is formula VII of the instant invention and the defined substituents of Formula I in '804 are identical.

Conclusion

Claims 1, 9, 19-28 and 30 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cybille Delacroix-Muirheid whose telephone number is (703) 306-3227. The examiner can normally be reached on Tue-Fri from 8:30 to 6:00. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward PhD, can be reached on (703) 308-4028. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

CDM *CDM*
Oct. 11, 1999

MPW
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